DEC 3 - 2003
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No. 03-326

IN THE

Supreme Court of the United States

RARITAN COMPUTER, INC.,

Petitioner,

v.

APEX INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

REPLY BRIEF

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STATEMENT PURSUANT TO RULE 29.6

Petitioner's corporate disclosure statement was set forth at page *ii* of its Petition for a Writ of Certiorari, and there are no amendments to that statement.

INTRODUCTION

Apex argues — early and often — that the decision below follows "established precedent". Apex could not be more wrong. Since the Petition for Writ was filed on August 27, 2003, seventeen (17) additional claim interpretation cases have been decided by the Federal Circuit. Ten (10) of those decisions follow the traditional approach of interpreting claims on the basis of the intrinsic evidence. The other seven (7) are "dictionary" cases.

In a November 20, 2003 opinion, the Federal Circuit started backpedaling from its recent embrace of dictionaries. *See Combined Systems, Inc. v. Defense Technology Corporation of America, et al.*, 2003 U.S. App. LEXIS 23633, discussed *infra*. This is too little, too late. District court judges are already rushing to their dictionaries. Why not? It is far easier to interpret a claim with a dictionary than it is to actually read and understand a patent and its file history. The problems, however, with the dictionary approach are manifest and manifold. It will as often as not lead to improper claim interpretations. It makes a mockery of the public notice function of intrinsic evidence. And it ignores over a century of Supreme Court precedent.

REASONS FOR GRANTING THE PETITION

I. Standard Claim Interpretation Procedures

Traditionally, courts have interpreted patent claims on the basis of the intrinsic evidence, *i.e.*, the claims themselves, the patent specification and its prosecution file history before the United States Patent and Trademark Office. This claim interpretation procedure has been repeatedly endorsed by the Supreme Court, most recently in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996). Until recently, the Federal Circuit scrupulously followed this procedure. *See, e.g., Cybor Corp. v. FAS Technologies, Inc., et al.*, 138 F.3d 1448, 1462 (Fed. Cir. 1998):

> In the course of seeking to understand the nature and scope of the invention set forth in the claims, it is standard doctrine that the judge focuses on the language of the claims, as explained by the patent's written description, and as constrained by the course of the patent's prosecution.

In his *Cybor* concurrence, Chief Judge Mayer further set forth the accepted use of dictionaries and other extrinsic evidence based on Supreme Court precedent. *Id.*

> If need be, the trial judge may seek understanding outside the patent proper, from relevant texts and materials, and from experts in the art. None of this involves "fact-finding" in the sense of the traditional fact-law dichotomy. See, for example, the Supreme Court's effort to decide whether a tomato was a "fruit" or a "vegetable." Regarding the meaning of those words, the Court said: "Of that meaning the court is bound to take judicial notice, as it does in regard to all words in our own tongue; and upon such a question dictionaries are admitted, not as evidence, but only as aids to the memory and understanding of the court." *Nix v Hedden*, 149 U.S. 304, 306-7 (1893).

II. Dictionary-Based Claim Interpretation Deviates From Supreme Court Precedent

Despite this long-standing, unambiguous Supreme Court instruction, one Federal Circuit judge recently suggested that it is improper to even consult the specification or prosecution history if a term's meaning is clear from dictionaries or treatises. The intrinsic evidence is reviewed only to determine if the patentee has somehow rebutted the dictionary definition. *Genzyme Corporation, et al. v. Transkaryotic Therapies, Inc.*,

2003 U.S. App. LEXIS 20703, pp. 33-34. In other words, it is now preferable to determine patent infringement without actually reviewing the patent!

Experienced patent attorneys are unable to ascertain the meaning of claims without careful consideration of the specification. It is naive in the extreme to suggest that the scope of an invention may be gleaned from reviewing the claims alone. *See, e.g.*, Claim 1 of Beasley, *et al.* United States Patent No. 5,937,176. No judge could possibly interpret a page-long claim without at least the technical guidance supplied by the intrinsic evidence. Defendant's expert — a professor of electrical engineering at Princeton University — admitted that he could not. How then could a judge feel competent to interpret such a complicated claim with nothing more than a dictionary in hand?

Here, the District Court did its job properly. It reviewed the claims, the patent, the file history and then listened to several days of expert testimony before rendering its claim interpretations. The Federal Circuit reversed in part, on the basis of nothing more than several dictionary definitions that were not in evidence. This approach cannot work and is clearly improper in view of *Nix* and other Supreme Court precedent.

III. The Federal Circuit Apparently Recognizes That The Dictionary Cases Go Too Far

In *Combined Systems*, the district court did exactly what the Federal Circuit's dictionary cases call for — it interpreted a disputed claim term on the basis of a dictionary definition. The Federal Circuit was less than enthusiastic in reaping what it had sown:

> Its opinion on claim construction, though, suggests it may have read some isolated statements in certain recent opinions too rigidly and in isolation from the entire body of our claim construction jurisprudence.

> Specifically, after discussing the dictionary definition of "fold," and before reviewing pertinent portions of the written description, the district court stated: "Even when the ordinary meaning of a term appears to be clear from the claim language, however, it is necessary to read the claim in the context of the specification to determine whether the patentee has given the phrase 'forming folds in said . . . body' an unaccustomed meaning." Apr. 19 Op. If, which we doubt, this language indicates that the district court believed that our cases permit consulting the specification solely for the limited purpose of determining whether it contradicts the dictionary meaning of a claim term, such a view is not supported by our case law, read as a whole.

Id. at p. 21.

This tactical retreat by the Federal Circuit comes too late to help Petitioner. Nor does it prevent the Federal Circuit from backsliding into error. What is needed is Supreme Court affirmation of the principal role of intrinsic evidence. The Federal Circuit has lost sight of the fact — pointed out by this Court in *Markman* — that claim interpretation is a "mongrel" practice, *i.e.*, it incorporates elements of both law and fact. In his *Cybor* concurrence, Chief Judge Mayer foresaw the potential problems with the blindly de novo review of claim interpretation presently practiced by the Federal Circuit:

> [W]ithout the benefit of a full record from the trial court, it is neither the function of this court nor is it within our capacity as an appellate court to adopt new interpretations, most especially not if the interpretation under review is of terms informed by conflicting evidence. Such indiscriminate and conclusive review deprives the parties of important

> substantive and procedural mechanisms provided in the trial courts, where interpretation can be informed by additional discovery and expert testimony, and where it can be checked by appellate review as a matter of right. If claim construction is only a question of law to be reviewed by this court de novo, then the absence of review as a matter of right over our claim constructions, which may be new and unsupported by legal analysis, or may never have been tested by the adversarial process, would transform this court into a trial court of first and usually last resort.

Cybor, 138 F.3d at 1466.

Judge Mayer's warning has proved prophetic. The Federal Circuit (or at least a portion thereof) has become a court of first and last resort where, as here, it relies on dictionaries that were not in evidence.

CONCLUSION

The Court should grant this petition for a writ of certiorari.

Respectfully submitted,

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